

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of:

Jeffrey A. Tilton et al. Attorney Docket No.: 25363A

Serial No.: 10/789,143 Group Art Unit: 1794

Filed: February 27, 2004 Examiner: Piziali, Andrew T.

For: LAYERED POLYMER FIBER INSULATION AND  
METHOD OF MAKING THEREOF

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Appellant responds to the Notification of Non-Compliant Appeal Brief (“Notification”) mailed January 27, 2009 by respectfully traversing and requesting entry of the previously filed Appeal Brief.

The first objection is that “the brief fails to indicate that the request for reconsideration filed 6/19/2008 was entered by the examiner in the Advisory Action mailed 6/26/2008.” No rule requires the identification of any “request for reconsideration” in an Appeal Brief. Rather, as indicated in “section (3)” of the Notification, the rule requires the identification of an “amendment” filed subsequent to the final rejection. *See 37 CFR 41.67(c)(iv) “Status of amendments.* A statement of the status of any amendment filed subsequent to the close of prosecution.”) Appellant filed no amendment subsequent to the final rejection, so the rule has been followed and the form of the Appeal Brief is proper.

The second objection is that “the brief lists each ground of rejection on appeal under the status of the claims section rather than properly listing them under the grounds of rejection to be reviewed on appeal section.” Respectfully, this is not an accurate characterization of the Appeal

Brief. Appellant's "Status of the Claims" section identifies the claims and their status (e.g., rejected) and provides a reason why:

### **III. STATUS OF THE CLAIMS**

Claims 1-27 remain pending in the application and are the subject of this appeal.

Claims 10, 20, and 25 are rejected as allegedly violating 35 U.S.C. Section 112, ¶2.

Claim 25 is rejected as allegedly violating 35 U.S.C. Section 112, ¶1.

Claim 25 is rejected as being anticipated under 35 U.S.C. Section 102(b) by either U.S. Patent No. 5,616,408 to Oleszczuk et al. ("Oleszczuk") or U.S. Patent No. 5,804,512 to Lickfield et al. ("Lickfield").

Claims 1-5, 11, 12, 25 and 26 are rejected as anticipated under 35 U.S.C. Section 102(b) by U.S. Patent No. 6,022,818 to Welchel et al. ("Welchel").

Claims 1-5, 9-15, 19-22, and 24-27 are rejected as being obvious under 35 U.S.C. Section 103(a) in view of Oleszczuk, Lickfield, and Welchel.

Claims 1-5, 11-15, 21-22, and 25-27 are rejected as being obvious under 35 U.S.C. Section 103(a) in view of Welchel and U.S. Patent No. 5,958,186 to Holm ("Holm"), U.S. Patent No. 6,692,606 to Cederblad ("Cederblad"), or U.S. Patent No. 6,761,710 to D'Acchioli ("D'Acchioli").

Claims 6-8 are rejected as being obvious under 35 U.S.C. Section 103(a) alternatively in view of: (a) Welchel and U.S. Patent No. 4,813,948 to Insley ("Insley") (b) Oleszczuk, Lickfield, Welchel, and Insley; or (c) Welchel, Holm, Cederblad, D'Acchioli, and Insley.

Claims 9 and 10 are rejected as being obvious under 35 U.S.C. Section 103(a) alternatively in view of: (a) Welchel, Oleszczuk, and Lickfield; or (b) Welchel, Holm, Cederblad, D'Acchioli, Oleszczuk and Insley.

Claims 16-18 are rejected as being obvious under 35 U.S.C. Section 103(a) alternatively in view of: (a) Oleszczuk, Lickfield, Welchel, and Insley; or (b) Welchel, Holm, Cederblad, D'Acchioli, and Insley.

Claims 19-20 are rejected as being obvious under 35 U.S.C. Section 103(a) in view of Welchel, Holm, Cederblad, D'Acchioli, Oleszczuk, and Insley.

Claim 23 is rejected as being obvious under 35 U.S.C. Section 103(a) alternatively in view of: (a) Oleszczuk, Lickfield, Welchel, U.S. Patent No. 6,548,431 to Bansal ("Bansal"), and

U.S. Patent No. 4,508,113 to Malaney (“Malaney”) or (b) Welchel, Holm, Cederblad, D’Acchioli, Bansal, and Malaney.

Claim 24 is rejected as being obvious under 35 U.S.C. Section 103(a) in view of Welchel, Holm, Cederblad, D’Acchioli, Oleszczuk, and Lickfield.

In contrast, Appellant in the “Grounds of Rejection to be Reviewed on Appeal” specifically lists those rejections presented for review:

#### **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The Board must determine whether claims 10, 20, and 25 meet the requirements of 35 U.S.C. Section 112 of the Patent Act. The Board must further determine whether: (1) claim 25 is anticipated by Oleszczuk or Lickfield; (2) claims 1-5, 11, 12, 25, and 26 are anticipated by Welchel; (3) claims 1-5, 9-15, 19-22, and 24-27 are obvious in view of Oleszczuk, Lickfield, and Welchel; (4) claims 1-5, 11-15, 21-22, and 25-27 are obvious in view of Welchel and Holm, Cederblad, or D’Acchioli.

Hence, “a concise statement of each issue presented for review” (37 CFR 41.67(c)(vi)) is properly listed in the appropriate section, and full compliance with the applicable rule has been made.

Finally, the Examiner objects because the “brief fails to present an argument under a separate heading for each ground of rejection on appeal and place any claim argued separately under a subheading.” First of all, Appellant notes that there is no requirement in the applicable rule to “place any claim argued separately under a subheading,” as the Examiner seems to assert.

Secondly, Appellant did in fact provide a heading for “each ground of rejection on appeal” (as identified in Section 6 of the Brief) as follows:

#### **VII. ARGUMENT**

- A. **CLAIMS 10 AND 20 MEET THE REQUIREMENTS OF 35 USC SECTION 112, ¶2**
- B. **CLAIM 25 MEETS THE REQUIREMENTS OF 35 USC SECTION 112, ¶1**
- C. **CLAIM 25 MEETS THE REQUIREMENTS OF 35 USC SECTION 112, ¶2**
- D. **CLAIM 25 IS NOT ANTICIPATED BY OLESZCZUK OR LICKFIELD**
- E. **CLAIMS 1-5, 11, 12, 25, AND 26 ARE NOT ANTICIPATED BY WELCHEL**

F. CLAIMS 1-5, 9-15, 19-22, AND 24-27 ARE UNOBlOUS  
OVER OLESZCZUK, LICKFIELD, AND WELCHEL

G. CLAIMS 1-5, 11-15, 21-22, AND 25-27 ARE UNOBlOUS OVER WELCHEL  
IN VIEW OF HOLM, CEDERBLAD, OR D'ACCHIOLI

Appellant therefore respectfully submits that compliance with the rule has been made.

In light of the foregoing, entry of the Appeal Brief is respectfully requested. Please debit any fee due from Deposit Account 50-0568.

Respectfully submitted,

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